

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIM J. HANSEN

Appeal No. 2004-0388
Application No. 09/749,620

ON BRIEF

Before GARRIS, PAK, and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 2, 6-20 and 22. Claim 5, which is the only other pending claim, has been allowed.

THE INVENTION

The appellant claims a defibrillator system that audibly indicates a functional status of the defibrillator in response to a real-time user-triggered inquiry. Claims 1 and 7 are illustrative:

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1. A defibrillator system, comprising:
a defibrillator; and
at least one audible indicator connected to the defibrillator for
generating an audible indication of a functional status of the
defibrillator in response to a real-time user-triggered inquiry.

7. The defibrillator system according to claim 1, wherein the
audible indicator generates words to indicate status.

THE REFERENCES

Tacker, Jr. et al. (Tacker)	6,006,132	Dec. 21, 1999
Owen et al. (Owen)	6,148,233	Nov. 14, 2000
Olson et al. (Olson)	6,366,809	Apr. 2, 2002
		(filed Apr. 8, 1998)

THE REJECTIONS

Claims 1, 10-15, 18 and 19 stand rejected under 35 U.S.C.
§ 102(e) as being anticipated by Owen. The claims stand rejected
as being obvious under 35 U.S.C. § 103 as follows: claims 2, 16,
17, 20 and 22 over Owen in view of Olson; claims 6-9, 16 and 22
over Owen in view of Tacker; and claims 1, 2, 6-20 and 22 over
Olson in view of Owen and Tacker.

OPINION

We reverse the aforementioned rejections. Under 37 CFR
§ 1.196(b) we enter a new ground of rejection of claims 1, 7, 10-
14, 16, 18, 20 and 22. Regarding the reversed rejections, we
need to address only the sole independent claim, i.e., claim 1.

Rejection under 35 U.S.C. § 102(e)

The portion of Owen relied upon by the examiner discloses an external defibrillator having a response button which, to confirm patient consciousness or lack thereof, is pushed in response to a "please respond" verbal message (col. 20, lines 64-66). The response button terminates a current defibrillation and, in some embodiments, disarms the defibrillator (col. 20, lines 54-58). The defibrillator confirms, by issuing both audio and visual messages, that the response button has been pushed (col. 20, lines 62-64).

The examiner argues that "[i]ndicating that all defibrillations are cancelled is providing an audible indication of the functional status of the defibrillator as claimed, i.e. that the defibrillator is now in an inactive state" (answer, page 4). What the appellant's claim 1 requires, however, is a system capable of indicating a functional status of the defibrillator in response to a real-time user-triggered inquiry. Owen's system does not provide such an inquiry, and Owen's response button merely shuts off the defibrillator. The status which pushing Owen's response button makes known is the status after the response button has been pushed, not a status to which an inquiry is directed.

The examiner, therefore, has not carried the burden of establishing a *prima facie* case of anticipation of the appellants' claimed defibrillator system over Owen. Accordingly, we reverse the rejection under 35 U.S.C. § 102(e).

*Rejection under 35 U.S.C. § 103
over Owen in view of Olsen*

Olsen discloses an external defibrillator which provides an audible charging indicator tone to indicate when the defibrillator has built up a charge to defibrillate a patient with a defibrillation shock (col. 2, lines 46-49), and includes a battery power status indicator (60) having a plurality of green indicator lights (62) and a red replacement light (64).¹ Also, if faults are identified during a daily or weekly defibrillator self-test, an alarm is activated (col. 6, lines 53-55).

Olsen does not remedy the above-discussed deficiency in Owen as to independent claim 1. We therefore reverse the rejection of dependent claims 2, 16, 17, 20 and 22 over Owen in view of Olson.

¹ "Green indicator lights are arranged with a sufficient number of lights so that an operator can determine the proportional amount of remaining battery capacity by looking at the number of lights illuminated. For example, if indicator **62** includes four lights, illumination of all four green lights indicates full battery status while illumination of three lights indicates three-quarter battery status and illumination of two battery lights indicates one-half battery status, and so on" (col. 3, lines 29-37).

*Rejection under 35 U.S.C. § 103
over Owen in view of Tacker*

The examiner relies upon Tacker only for a disclosure of a defibrillator "having an audio signal that varies the frequency, pitch, or volume, and uses words for the purpose of better attracting the attention of a user" (office action mailed February 3, 2003, paper no. 9, page 3), and not for any disclosure that remedies the above-discussed deficiency in Owen as to independent claim 1. Consequently, we reverse the rejection of dependent claims 6-9, 16 and 22 over Owen in view of Tacker.

*Rejection under 35 U.S.C. § 103
over Olson in view of Owen and Tacker*

The examiner argues that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Olson with a real time user triggered inquiry as, for example, taught by Owen and Tacker in order to allowing [sic] a user to check the status and operation of the device whenever the user desires" (answer, page 4). As indicated by the above discussion of Owen, this reference does not disclose an audible indicator connected to the defibrillator for

generating an audible indication of a functional status of the defibrillator in response to a real-time user-triggered inquiry. Such an audible indicator is disclosed by Tacker (col. 5, lines 21-25; col. 6, lines 58-64). However, the examiner has not addressed the characteristics of the defibrillators of Olson and Tacker and explained why, in view of these characteristics, the references themselves would have led one of ordinary skill in the art to use Tacker's audible indicator with Olson's defibrillator. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Accordingly, we reverse the rejection over Olson in view of Owen and Tacker.

New ground of rejection

Claims 1, 7, 10-14, 16, 18, 20 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tacker.

Claims 1 and 7: Tacker discloses an implantable defibrillator having a portable communication device (110) which can transmit real-time, user-triggered functional status request commands to the defibrillator and which can play a prestored, appropriate audible voice message in response to functional status information received from the defibrillator (col. 5, lines 21-25; col. 6, lines 58-64). The appellant argues that Tacker's portable communication device is not connected to the

defibrillator (brief, pages 8-9; reply brief, pages 6-7). During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The appellant's specification states that "[a]nother specific embodiment transmits a status inquiry to the wireless communication port, thus initiating a status report" (page 14, lines 18-20), and that "[t]he triggering and/or the indication could be produced remote to the defibrillator" (page 17, lines 15-16). Hence, the broadest reasonable interpretation, in view of the appellant's specification, of "connected to" in the appellant's claim 1 includes connection for wireless communication. Tacker, therefore, anticipates the defibrillator system claimed in the appellant's claims 1 and 7.

Claim 10: Tacker's switch 119 is a user-activated trigger for initiating a query of the functional status of the defibrillator (col. 6, lines 60-61).²

² It appears that the last word in claim 10 should be "defibrillator" instead of "indicator".

Claim 11: Tacker's disclosure that switch 119 is a press switch (col. 5, line 63) indicates that it is a button.

Claim 12: Tacker's press switch 119 necessarily must be pressed for a sufficient duration to make electrical contact and thereby initiate the query.

Claim 13: Tacker's audible indicator indicates results of the query (col. 6, lines 58-64).

Claim 14: Tacker's system may also include an LED display for indicating the results of the query (col. 8, lines 6-8).

Claims 16 and 20: Tacker's disclosure that the query can be initiated while the capacitor is charging (col. 6, lines 58-61) indicates that the user-activated trigger can initiate a query while the defibrillator is turned off.

Claim 18: Tacker's switch 119 is remote from the defibrillator (figure 1).

Claim 22: The audible indicator is capable of periodically indicating a functional status of the defibrillator, for example, when the capacitor is fully charged and at the beginning of each stage of an intervention sequence (col. 6, lines 46-58).

DECISION

The rejections of claims 1, 10-15, 18 and 19 under 35 U.S.C. § 102(e) over Owen, and the rejections under 35 U.S.C. § 103 of claims 2, 16, 17, 20 and 22 over Owen in view of Olson, claims 6-9, 16 and 22 over Owen in view of Tacker, and claims 1, 2, 6-20 and 22 over Olson in view of Owen and Tacker, are reversed. A new ground of rejection of claims 1, 7, 10-14, 16, 18, 20 and 22 has been introduced under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED, 37 CFR § 1.196(b)

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Bradley R. Garris)	
Administrative Patent Judge)	
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Chung K. Pak)	
Administrative Patent Judge)	APPEALS AND
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Terry J. Owens)	
Administrative Patent Judge)	

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